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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,173	02/04/2004	Rene E. Kristiansen	PA 06 0013	5179

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EXAMINER	
WANG, QUAN ZHEN	

ART UNIT	PAPER NUMBER
2613	

MAIL DATE	DELIVERY MODE
03/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/772,173	**Applicant(s)** KRISTIANSEN, RENE E.	
	Examiner Quan-Zhen Wang	**Art Unit** 2613	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☒ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *10,13-16,19-21,25,27,28 and 30-38*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE:
The Amendments of fig. 4 and the specification contain new matter that is not supported by the specification originally filed.

Continuation of 11. does NOT place the application in condition for allowance because:
Applicant's arguments filed February 20, 2007 have been fully considered but they are not persuasive.

Applicant first argues the prior art Thomas does not include a delay element. However, as it is admitted by Applicant, Thomas clearly illustrates fiber 1b has additional length. It is a common knowledge that optical fiber delays optical signal. Therefore, the additional fiber length of Thomas is considered as "delay element". Applicant argues that first coupler of Thomas "uses unidirectional ports and not bidirectional ports as provided in the claimed invention". However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For the instant case, the APA provides the first coupler with bidirectional ports and Thomas is used to shown that delay between two couplers is well known in the art. Therefore, the rejections of claims 10, 13-16, 19-21, 25, 27, 28, 31, 32, 34, 35, 37, and 38 still stand.

Applicant argues that "Jutamulia does not include any additional combination disclosure combinable with the Admitted Prior Art or the Thomas". However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For the instant case, the modified system of the APA and Thomas differs from the claimed invention in that the APA and Thomas do not disclose that the delay element comprising a pair of electrodes. For example, Jutamulia discloses a delay element comprising a pair of electrodes (fig. 8, electrodes 92). Therefore, it would have been obvious for one of ordinary skill in the art at the time when the invention was made to incorporate a delay element comprising a pair of electrodes, as it is disclosed by Jutamulia, in the modified system of the APA and Thomas in order to actively adjust the optical delay. Applicant argues that Jutamulia patent discloses waveguides 72 and 74 having different lengths to produce a delay D, as opposed to using a delay element as required in the claimed invention. However, in accordance with MPEP, "USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997)". The Delay D of Jutamulia reads the claimed delay element when the claim is given to its broadest reasonable interpretation for the instant case. Therefore, the rejections of claims 30, 33, and 36 still stand.

Applicant further argues that the final rejection should be withdrew because "a clear issue has not been developed between the Examiner and application with respect to the Thomas, et al. and Jutamulia patents". However, in accordance with MPEP, "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ... In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the examiner should be on guard not to allow such claims. See MPEP § 714.04. The claims may be finally rejected if, in the opinion of the examiner, they are clearly open to rejection on grounds of record" (See MPEP §706.07(a)). For the instant case, Applicant's amendments of the claims necessitated the new grounds of rejection and, therefore, the final rejection is proper in accordance with MPEP..

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